

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-51 remain in this application.

Claims 1-4, 6-7, 9-15, 18, 23-24, 29, 30-33, 35-39, 42, 47, 50 and 51 were rejected under 35 U.S.C. §102(e) as being anticipated by Uppaluru (U.S. 6,400,806). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites "uploading means for independently uploading [a] plurality of interactive voice response applications through a second telecommunication network by a plurality of independent value-added service providers" wherein "at least a plurality of said plurality of interactive voice response applications uses a common speech recognition module run on said system". Claim 29 recites similar limitations at lines 5-11. Claim 30 recites similar limitations at lines 6-10. Uppaluru does not teach these claim limitations.

Uppaluru is a system made up of a plurality of voice web sites 102 and voice web gateways 105 (see col. 5, lines 1-2). However, nowhere does Uppaluru teach that its system can upload a plurality of interactive voice response applications which use a *common* speech recognition module run on the system. In fact, because Uppaluru teaches a distributed system using a plurality of voice web sites and voice web gateways, Uppaluru actually teaches away from the invention by suggesting that each site has its own speech recognition module. Thus, the claims are patentable over the reference.

Further, claim 1 recites that the memory stores a plurality of interactive voice response applications that are uploaded from a plurality of service providers. Claim 29 recites similar limitations at lines 5-8. Uppaluru does not teach support for a plurality of service provider applications in a single memory. Nor does Uppaluru teach "allowing each of a plurality of value-added service providers to set up an

interactive voice response application" as recited in claim 30. Accordingly, for these reasons as well, claims 1, 29 and 30 are patentable over the reference.

Claims 2-4, 6-7, 9-15, 18, 23-24, 31-33, 35-39, 42, 47, 50 and 51, which depend, directly or indirectly, upon one of the above claims, is thus patentable over the reference for at least the same reasons as the parent claim.

Claims 5, 8, 19, 27-28, 34, 43 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Uppaluru. Claims 16-17, 40-41, and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Uppaluru in view of Woods *et al.* (U.S. 6,510,417). For the following reasons, the rejection is respectfully traversed.

First, the above claims each depend, directly or indirectly, upon one of claims 1, 29 and 30. Because Woods does not overcome the shortcomings of Uppaluru identified for those parent claims, the cited claims are patentable over the combination of references as well.

Second, applicant disputes the Examiner's official notices and claims of inherency. Applicant notes that any teaching as "well known" as the Examiner claims could then be easily cited in a prior art reference. Taking "official notice" requires that facts outside of the record be capable of *instant* and *unquestionable* demonstration as being 'well-known' in the art (see MPEP §2144.03). Applicant disputes that this is the case. Hence applicant requests that such references be provided.

Further, a claim for inherency requires that the function or structure be necessary to the prior art disclosure. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to

reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112.

Furthermore, the Examiner has not provided the proper motivation for combining the references, or making the suggested modifications. Even if an element is "well known", the Examiner must provide some motivation for modifying the prior art reference to include that element.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Instead, the Examiner merely listed an advantage/benefit of the combination. This is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a *convincing line of reasoning* based on *established scientific principles* practiced by one skilled in the art that the advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention

'as a *whole*' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33226.

Respectfully submitted,

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